



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

#10/dpr
11-18-02
Pet file
restriction

APPLICANT: Bryan Bergeron

ATTY DOC#: 7436-1 (formerly 8100.01)

SERIAL No.: 09/992,328

ART UNIT: 3727

FILING DATE: November 19, 2001

EXAMINER: Stephen J. Castellano

TITLE: "Drinking Container"

The Honorable Commissioner of
Patents and Trademarks
Washington D.C. 20231

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TECHNOLOGY CENTER R3700

**PETITION TO (1) WITHDRAW RESTRICTION REQUIREMENT; (2)
REQUIRE REINSTATEMENT OF CLAIMS 2, 3, 6 AND 8-10 BASED ON THE
SUFFICIENCY OF THE DRAWINGS; AND (3) WITHDRAW NEW MATTER
REJECTIONS RELATED TO DRAWING AMENDMENTS AND TO REQUIRE
ENTRY OF APPLICANT'S FORMAL DRAWINGS**

Dear Commissioner:

Applicant respectfully petitions the Commissioner to: (1) withdraw a restriction requirement, thereby returning claims 7 and 11-17 to the case; (2) require reinstatement of claims 2, 3, 6, and 8-10 based on the sufficiency of the drawings; and (3) withdraw new matter rejections related to applicant's drawings and to require entry of applicant's formal drawings.

This application covers a simple drinking container that has no moving parts. The application originally contained 17 claims, but through the assertion of several unusual and overly technical objections, the Patent Office has limited examination of this

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application to only claims 1, 4, and 5. For the following reasons, withdrawal of the restriction requirement and the objections is respectfully requested.

1. Petition to Withdraw Restriction Requirement

The Patent Office required restriction on the basis that the application contains claims to Invention I (claims 1-10, drawn to a drinking container) and Invention II (claims 11-17, drawn to methods of using the drinking container claimed in claims 1-10). The Examiner also indicated that the application contains claims to two patentably distinct species, namely Group A (Fig. 2A and 2B), on which generic claim 1 and species claims 2-6, 8-10 read, and Group B (Fig. 4A and 4B), on which generic claim 1 and species claim 7 read. The Examiner's reason as to why the apparatus and method claims are independent and distinct inventions was simply that "the drinking cup can be used in a material different process of holding pencils." (February 19, 2002 Office Action, p. 2).

Applicant provisionally elected the invention of claims 1-10 (Invention I) with traverse, and requested reconsideration and withdrawal of the restriction requirement between claims 1-10 and 11-17 (i.e. Inventions I and II). The applicant also provisionally elected the species of Group A, on which generic claim 1 and species claims 2-6, 8-10 read. The election of species was made without traverse.

In the August 5, 2002 final office action, the examiner entered a final restriction requirement concerning claims 7 and 11-17. Applicant requests reconsideration and withdrawal of the restriction requirement because the Examiner has not made a prima facie showing that Invention I (apparatus; claims 1-10) and invention II (method of using the apparatus of invention I; claims 11-17), as claimed, are independent and distinct. Additionally, the restriction as to claim 7 should be withdrawn because claim 7 was never

subject to a restriction requirement. Claim 7 was subject to an election requirement, and should remain in the case because it depends directly from generic claim 1.

In order to meet its burden of establishing a prima facie basis for restriction, the Patent Office must provide (1) reasons why the inventions as claimed are independent or distinct, MPEP 806; and (2) the reasons for insisting upon restriction between the inventions. MPEP 808. It is respectfully submitted that the Patent Office has not met its burden under either of these criteria.

a) The Examiner has not made a prima facie showing that Inventions I and II are independent and distinct as claimed

35 U.S.C. § 121 provides, "If two or more independent and distinct inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions." (emphasis added). The Patent Office interprets the term "independent" to mean that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. MPEP 802.01. The Patent Office interprets "distinct" to mean that two or more inventions are (1) capable of separate manufacture, use or sale as claimed, and (2) patentable over each other. MPEP 802.01. Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction is never proper. MPEP 806.05; 808.02.

Invention I and Invention II are directly related because method claims 11-17 (Invention II) simply claim methods of using Invention I. For example, method claim 11 recites: "providing a drinking container according to *claim 1* . . ." Claims 12-17 simply add further structural limitations that are found in claims that depend from claim 1. The apparatus of claims 1-10 (invention I) and the methods of claims 11-17 (invention II) both provide a drinking container for assisting disabled persons in drinking fluids by reducing the degree of tilt necessary to drain the fluid from the container, thus permitting

consumption without requiring a user to tilt one's head. It is difficult to imagine how two claimed inventions could be more related. The Patent Office has provided no plausible reason why they are not.

The Examiner's reason for insisting on restriction consists of the following statement: "In the instant case, the drinking cup can be used in a materially different process of holding pencils." (February 19, 2002 Office Action, Paragraph 2). In making the restriction requirement final, the Examiner again stated: "the container which holds fluid is clearly capable of holding pencils without fluid . . ." (August 5, 2002 Office Action, p. 2). Surely much more than this cursory example is required in order to meet the Patent Office's *prima facie* burden under 35 U.S.C. § 121 of demonstrating that Inventions I and II are independent and distinct inventions. The Examiner's example does not cite material differences between Inventions I and II. The Examiner is neglecting to consider the invention as claimed, and appears to be importing additional properties (i.e. storage of solid materials) that are not even mentioned in applicant's patent application. If the Patent Office can restrict simply by asserting that applicant's apparatus can be used in a materially different process of holding pencils, then the statutory requirement of 35 U.S.C. § 121 has no meaning or force of law whatsoever.

b) The Examiner has not provided reasons for insisting on restriction between Inventions I and II

If the Patent Office contends that related inventions are distinct under the criteria of MPEP 806.05, the Patent Office must also explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search. MPEP 808.02. In the present case, the Examiner merely states that "[b]ecause these inventions are distinct ...and have acquired a separate status in the art as shown by there different classification, restriction for examination purposes as indicated are proper." (Paragraph 3 of the February 19, 2002 Office Action). This

statement does not address the criteria of MPEP 808.02, and does not provide the required explanation as to why the allegedly distinct inventions must be restricted.

Moreover, the Examiner has classified Invention II in class 604. (Paragraph 1 of the February 19, 2002 Office Action). Class 604 is defined as "Surgery," a class which has no relationship to the claimed drinking container of the invention. While class 604 does include subclass 78, "Drinking Cup," it would be necessary to search both classes for either Invention I or Invention II, assuming the classification is correct. Thus, there would not be an increased burden on the Patent Office if the restriction requirement were withdrawn. The statement that the inventions have acquired a separate status in the art is unsupportable because claims 11-17 merely claim methods for using the apparatus of claims 1-10. Accordingly, the search required for Invention I was the same as the search required for Invention II.

Additionally, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803. In this case, examination of Inventions I and II can clearly be made without serious burden on the examiner, because Invention II merely claims a process for using the apparatus of Invention I.

Because the Patent Office has not set forth reasons why Inventions I and II as claimed are independent or distinct and the reasons for insisting upon restriction, the Patent Office has not met its burden of establishing a prima facie basis for restriction. Accordingly, applicant requests withdrawal of the restriction requirement between Inventions I and II, and that examination proceed forward on claims 1-17.

2. Petition To Require Reinstatement Of Claims 2, 3, 6, And 8-10 Based On The Sufficiency Of The Drawings

In this application, the Patent Office has raised several unusual and overly technical objections to applicant's drawings. In the April 26, 2002 first office action, the Patent Office withdrew claims 2, 3, 6 and 8-10 on grounds that elements of these claims were not shown in applicant's original draft drawings. (Exhibit A). In response to the first office action, applicant specifically explained where the claimed elements were shown in the original draft drawings. Additionally, in an attempt to address the Patent Office's objections, applicant hired a professional patent draftsman and submitted formal drawings. (Exhibit B). In the August 5, 2002 final office action, the Patent Office maintained its withdrawal of claims 2, 3, 6 and 8-10 on grounds that claimed elements are not shown in the drawings. For the following reasons, the examiner's reasons for withdrawing claims 2, 3, 6 and 8-10 are unfounded.

Examiner's statement concerning applicant's drawings	Applicant's response
"The fluid diverter 4, flow channel 12 and spout 8 are all located on substantially the same surface and these elements have no specific delineation to separate these elements as shown in Fig 2B."	Patent drawings routinely include a main component (here, the fluid diverter 4) that has subcomponents formed thereon (here, the flow channel 12 and the spout 8). The relationship of these three components to one another is clearly described at page 9, line 16 – page 10, line 10 of the specification. Applicant does not understand the basis of this objection, nor how it would be possible to comply with it.
"The elected specie of Fig. 2A and 2B do not show a wedge shaped fluid diverter as claimed in claims 2 and 8-10 . . ."	<p>The wedge shaped configuration of the fluid diverter member is shown in the cross-section view of Figure 1A. See specification p. 8, lines 14-15; see also Figures 3A and 4A. The top view shown in Figure 2B includes a fluid diverter member 4 that is wedge shaped.</p> <p>If the examiner is taking the position that due to applicant's election, figures other than Figs. 2A and 2B cannot be relied upon as showing claimed features,</p>

	this is clearly incorrect. Applicant elected claims 1-10, not the species of Fig. 2A and 2B.
"the fluid diverter (4) is shown but an elevation cross-section is not shown to provide details of a wedge shape, . . ."	An elevation cross-section of the wedge shape is shown in Figure 1A, 3A, and 4A.
"[The drawings] do not show a flow channel extending lengthwise along an outer surface of said fluid diverter member as claimed in claims 3 and 8-10, . . ."	In Figures 1C, 2B, and 3B, the flow channel 12 is shown extending lengthwise along an outer surface of the fluid diverter member 4.
"a flow channel (12) is shown but it extends along an inner surface not an outer surface (the inner surface is contiguous with the fluid diverter (4)) . . ."	In the specification at page 9, line 19- page 10, line 2, applicant states, "As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an <i>outer</i> surface of the fluid diverter member 4." The applicant is free to be his own lexicographer, and in this case the applicant is simply using the word "outer surface" to refer to the outer surface of the fluid diverter 4 that is exposed on the inside of the cup. Applicant does not understand the significance of the examiner's comment that "the inner surface is contiguous with the fluid diverter (4)."
"do not show an extension spout extending upward and outward from the upper rim as claimed in claims 6 and 8-10 where the upper rim has an opening through at least a sipping region."	These items are clearly shown in Figures 1A, 1B, 1C, 2A, and 2B. The relationship and location of these items are described at page 10, lines 6-10: "The drinking container shown in Figure 1 includes an extension spout 8 extending upward and outward from the upper rim 16. The sipping region 16A is formed on the upper end of the extension spout 8. As shown in Figure 1, the extension spout 8 is contiguous with the fluid diverter member 4 to thereby assist the fluid diverter member 4 in compelling fluid through the sipping region 16A."
"The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flow channel extending lengthwise along an outer surface of the fluid diverter member as stated in claims 3 and 8-10 must be shown or the feature(s) canceled from the claims."	For the reasons set forth above, the flow channel is clearly shown in the drawings.

Undersigned has never filed a petition concerning drawing amendments, preferring instead to submit amended drawings in compliance with the Examiner's requirements. However, for the reasons set forth above, applicant does not understand how he could amend his drawings in order to satisfy the requirements of the Examiner. If the Commissioner denies applicant's petition concerning drawing amendments, applicant would appreciate clear guidance as to acceptable drawing amendments so that applicant can be certain that any further investments in patent drawings will meet with acceptance by the Patent Office.

3. Petition To Withdraw New Matter Rejections Related To Applicant's Drawings And Require Entry Of Applicant's Formal Drawings

In the final office action of August 5, 2002, the Examiner objected to applicant's formal drawings on grounds that they add new matter. The Examiner required applicant to submit amended drawings. Exhibit A contains applicant's original draft drawings, while Exhibit B contains applicant's amended drawings.

The new matter rejections are improper and unsupportable. First, the drawing features which the Examiner identified as new matter are undeniably disclosed in applicant's original drawings and specification, for the reasons set forth in the following table. Second, the Examiner raises form over substance by basing the new matter objections on extremely minor and unimportant differences between the original and formal drawings. In each case, the alleged "new matter" has absolutely no applicability or pertinence to the claims of the application. Accordingly, the new matter rejections should be withdrawn and the Examiner should be ordered to enter applicant's formal drawings.

Examiner's statement	Applicant's response
"The original disclosure does not support	The handles shown in formal drawing

the showing of a different shaped handle as shown in Fig. 1A and 1B,” “	Figures 1A and 1B are not significantly different from the original draft drawing Figures 1A and 1C. Any differences are not patentable distinctions; they are merely minor design modifications that were made by the professional draftsman who applicant hired to prepare his formal drawings.
“a differently shaped bottom as shown in Fig. 1C,”	The bottom of the cup shown in formal drawing Figure 1C is not significantly different from the original draft drawing Figure 1C. Any differences are not patentable distinctions; they are merely minor changes in shape and proportion that were made by the professional draftsman who applicant hired to prepare his formal drawings.
“different creases as shown on the interior of the fluid diverter, flow channel and spout in Figure 2B and as shown on the exterior of Fig. 2A near spout 8, etc.”	<p>The items shown in applicant’s original draft drawings are not “creases.” They are representative markings that were intended to indicate the curvature or contour of the flow channel 12. The professional draftsman who prepared applicant’s formal drawings replaced the contour lines of the original drawing with stippling, a technique that is widely used to show contours in patent drawings.</p> <p>This curvature is clearly described in the specification at page 10, lines 4-5: “In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls.”</p>

For the foregoing reasons, the modifications that the Examiner objects to do not constitute the addition of new matter. All of the features shown in the formal drawings were included in the original draft drawings and in the original specification. The changes are merely minor design modification or changes in drawing technique that were made by the draftsman who prepared the formal drawings. If all applicants were held to the standards that the present applicant is being held to, attempts to replace informal

drawings with formal drawings would become prohibitively expensive and unduly difficult, if not impossible. Rather than raise form over substance, applicant respectfully requests that the new matter rejections be withdrawn and that the formal drawings be entered.

Conclusion and Relief Requested

For the foregoing reasons, applicant respectfully petitions the Commissioner to:

- (1) withdraw a restriction requirement, thereby returning claims 7 and 11-17 to the case;
- (2) require reinstatement of claims 2, 3, 6, and 8-10 based on the sufficiency of the drawings; and
- (3) withdraw new matter rejections related to applicant's drawings and to require entry of applicant's formal drawings.

Respectfully submitted,



Shawn D. Sentilles, Reg. No. 38,299
WYATT, TARRANT & COMBS, LLP
1715 Aaron Brenner Drive, Suite 800
Memphis, TN 38120-4367
(901) 537-2192

Date: November 4, 2002



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EXHIBIT A

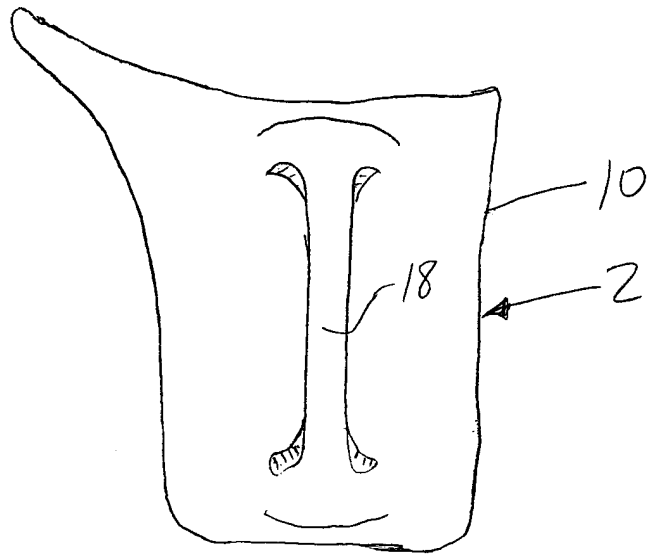


FIG. 1B

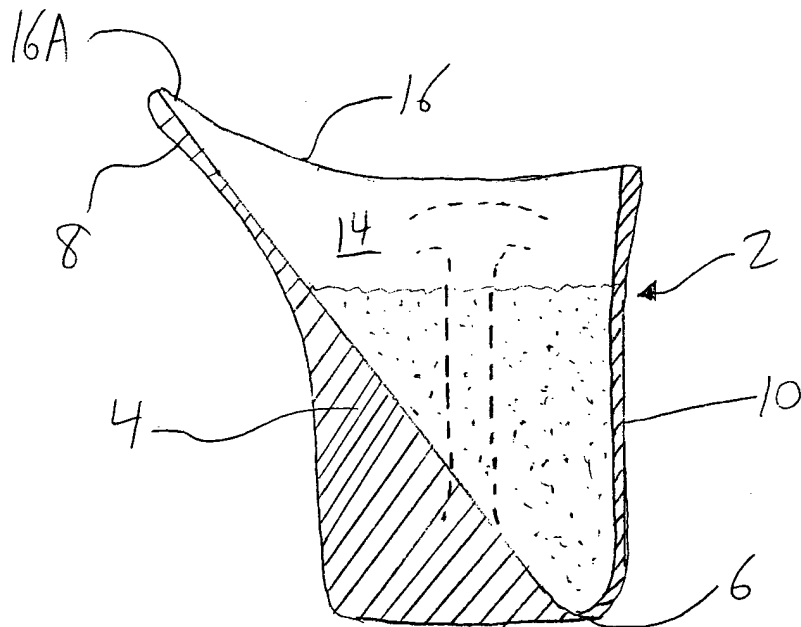


FIG. 1A

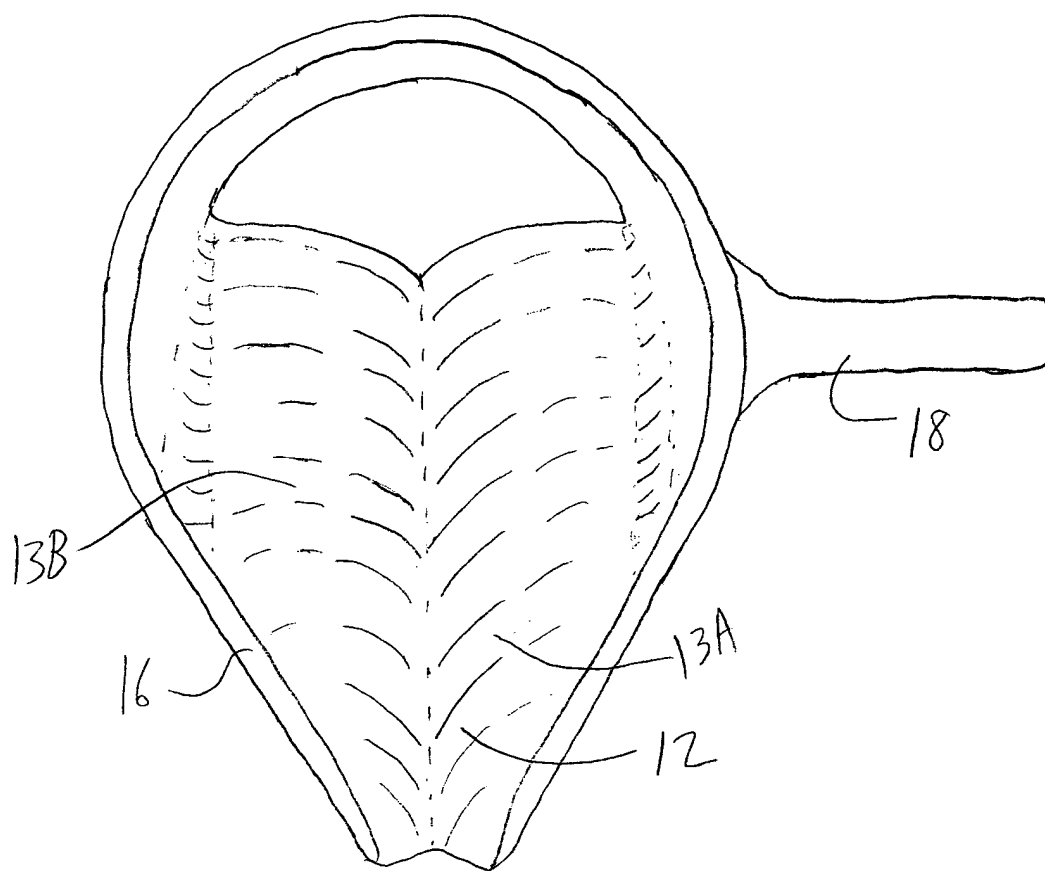


FIG. 1C



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TOP VIEW

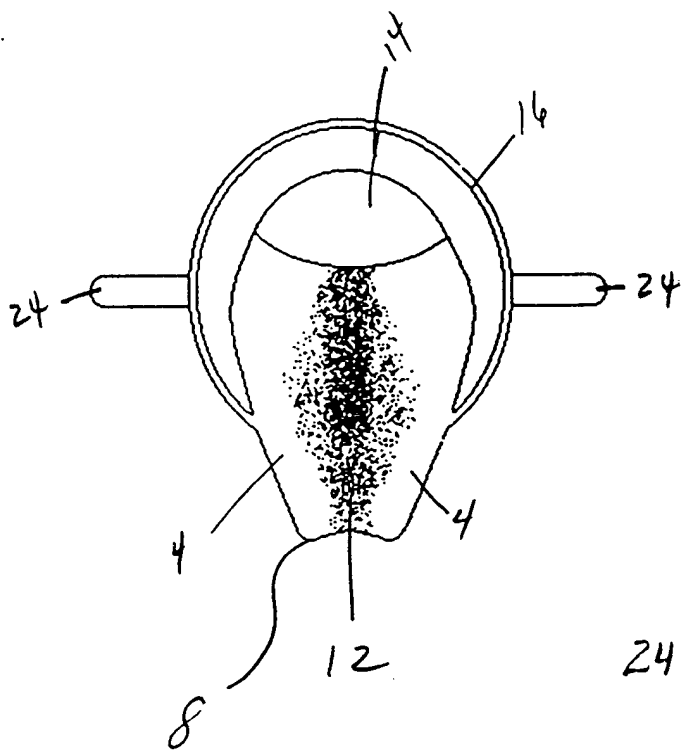


Fig. 2B

SIDE VIEW

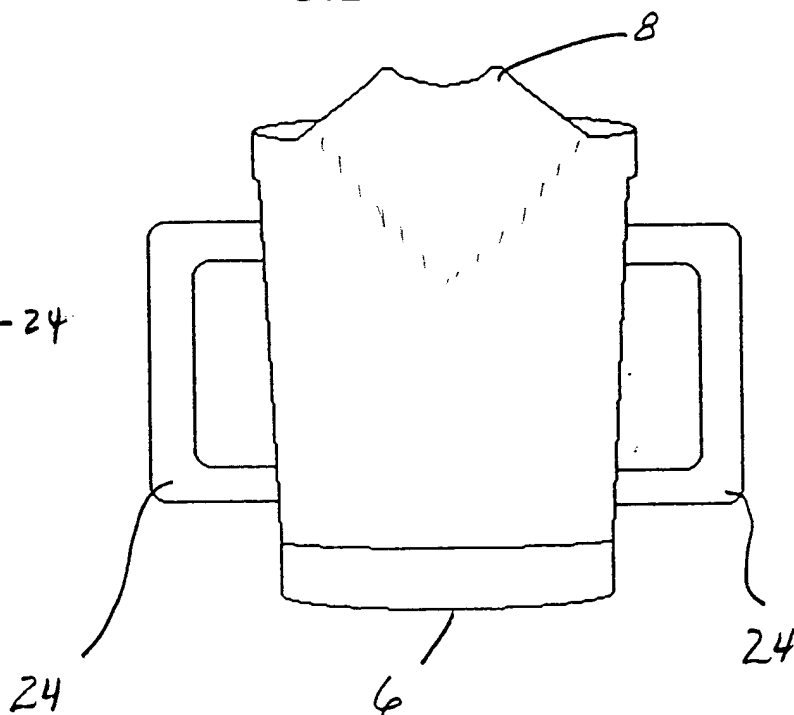


Fig. 2A



2

TOP VIEW

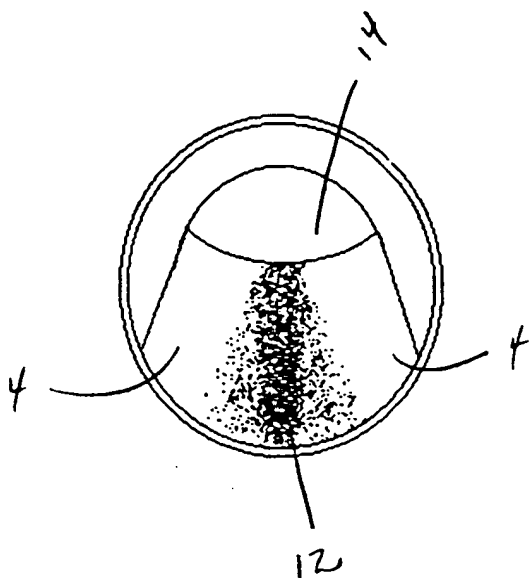


Fig 3B

SIDE VIEW

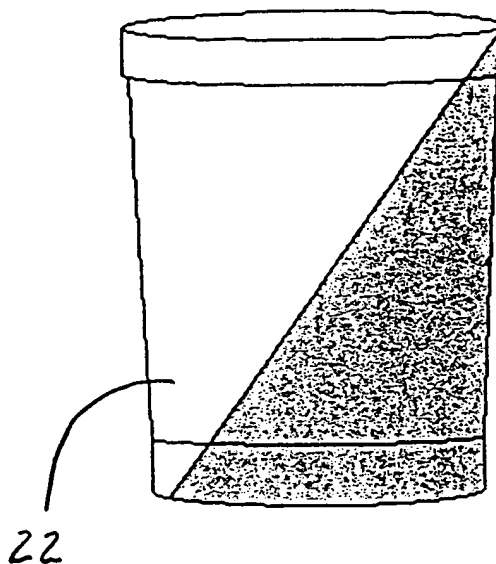


Fig 3A



2

TOP VIEW

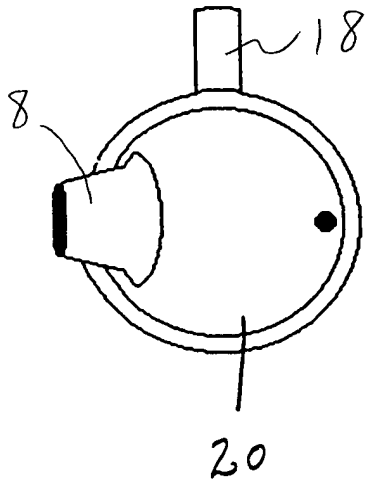


Fig. 4B

SIDE VIEW

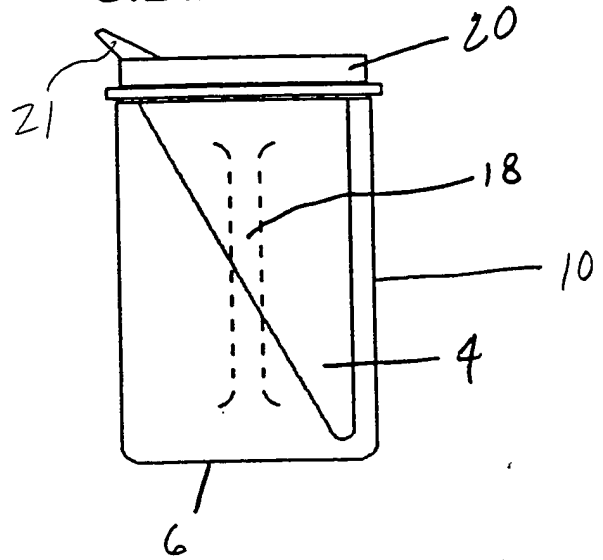


Fig. ~~5A~~ 4A



TOP VIEW

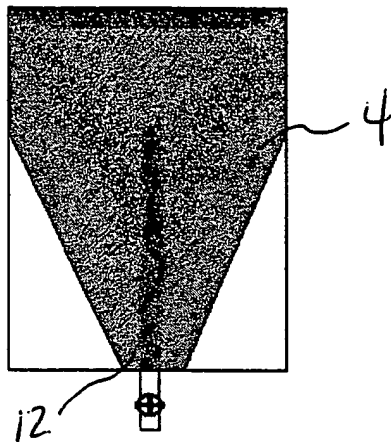


FIG. 6

SIDE VIEW

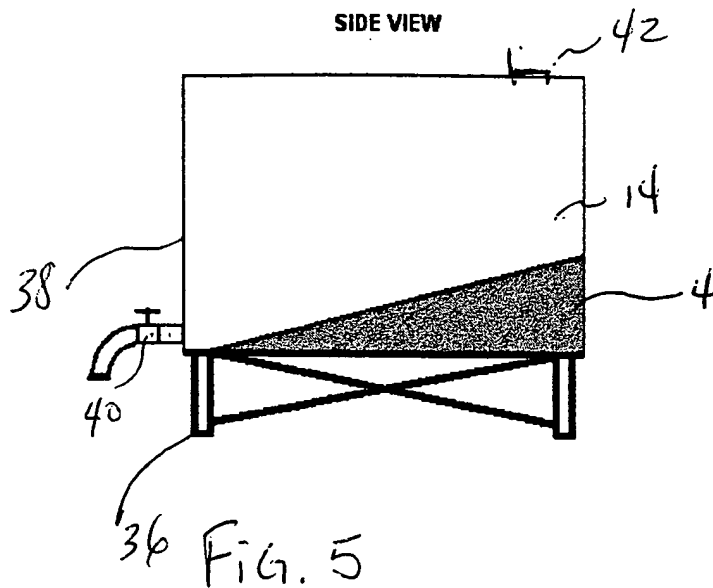




EXHIBIT B

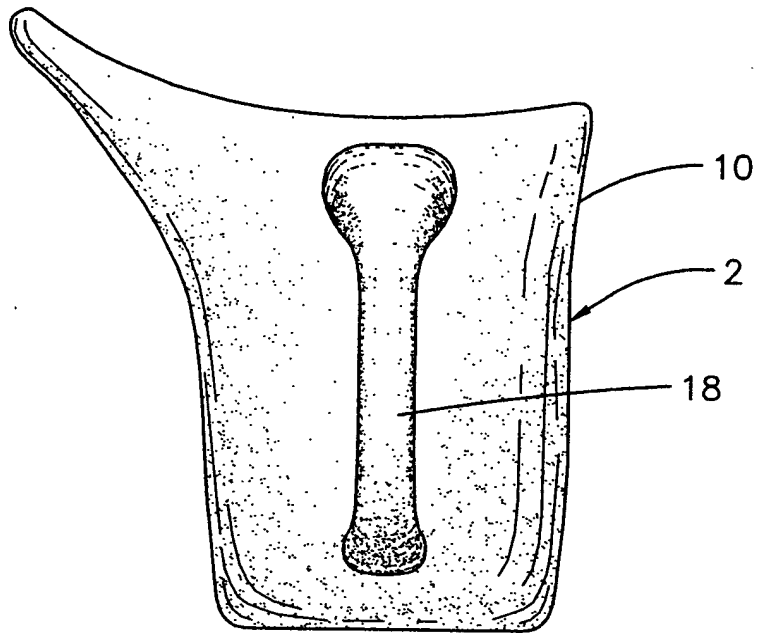


FIG. 1B

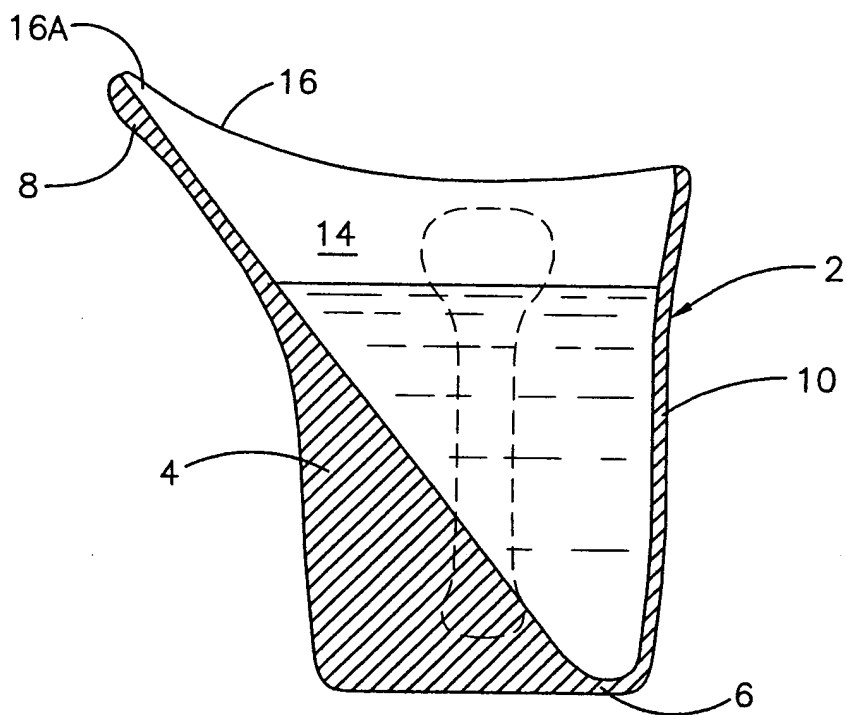


FIG. 1A

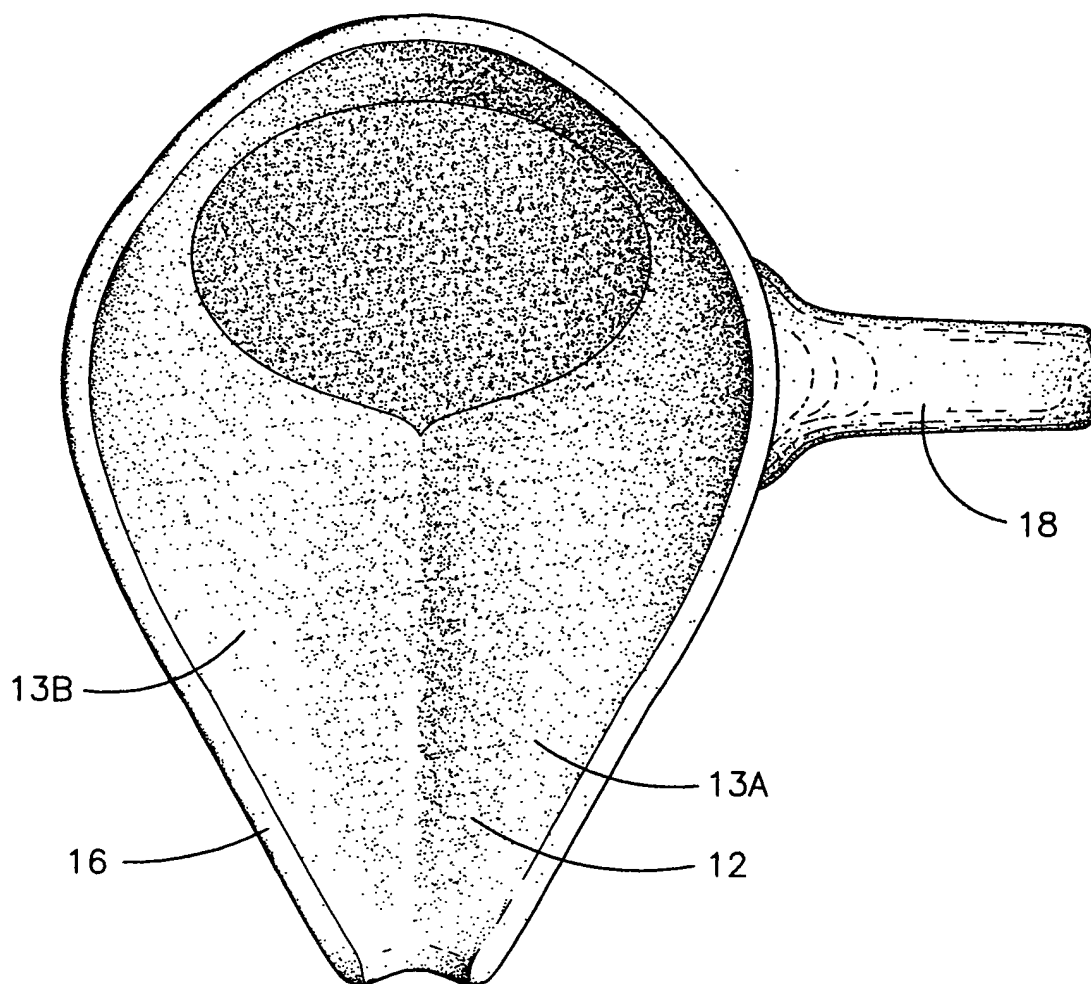


FIG. 1C

TOP VIEW

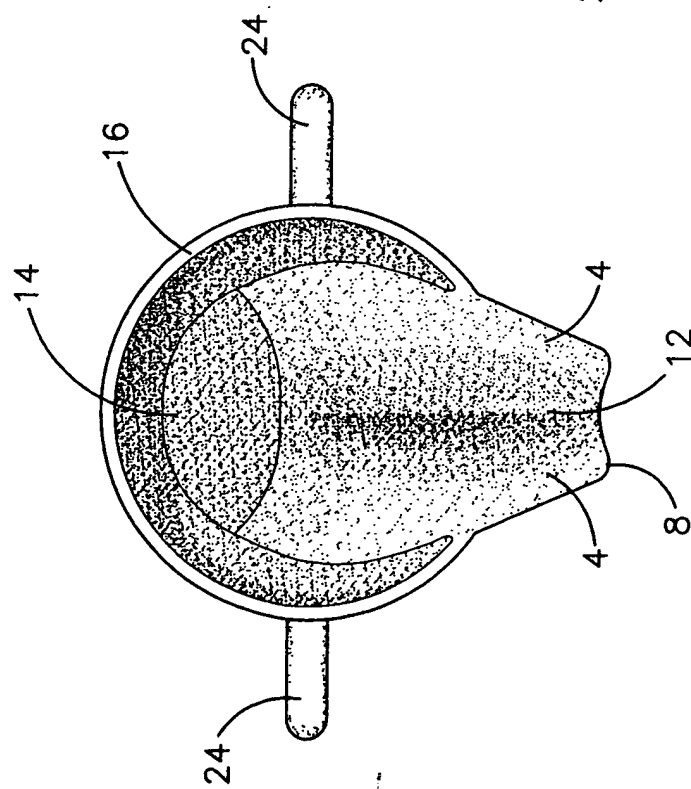


FIG. 2B

SIDE VIEW

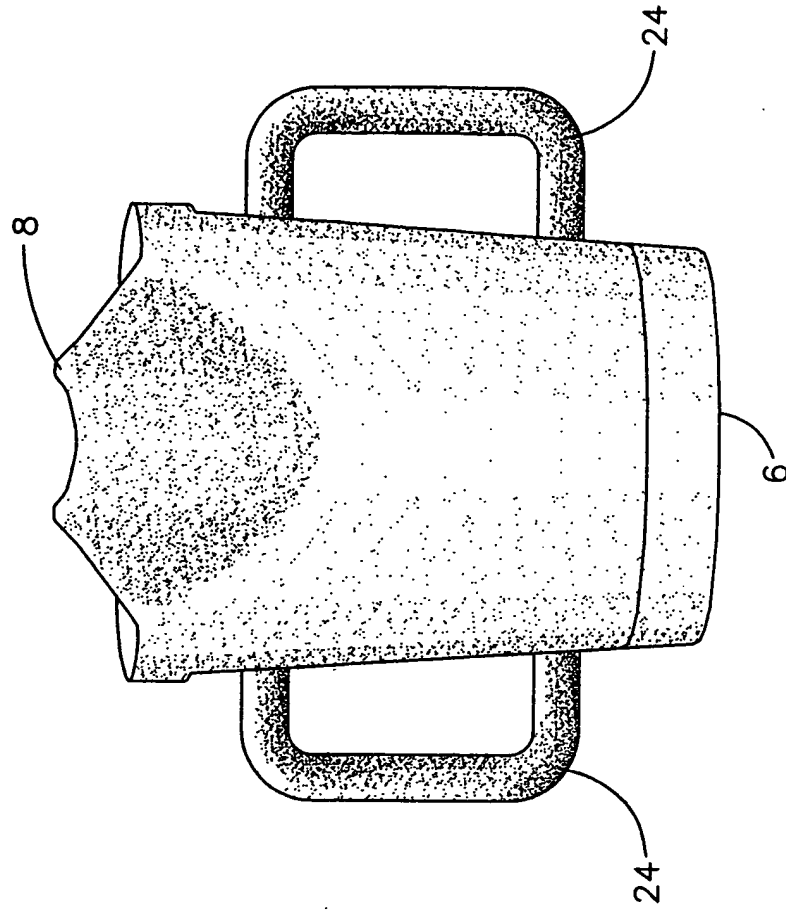


FIG. 2A

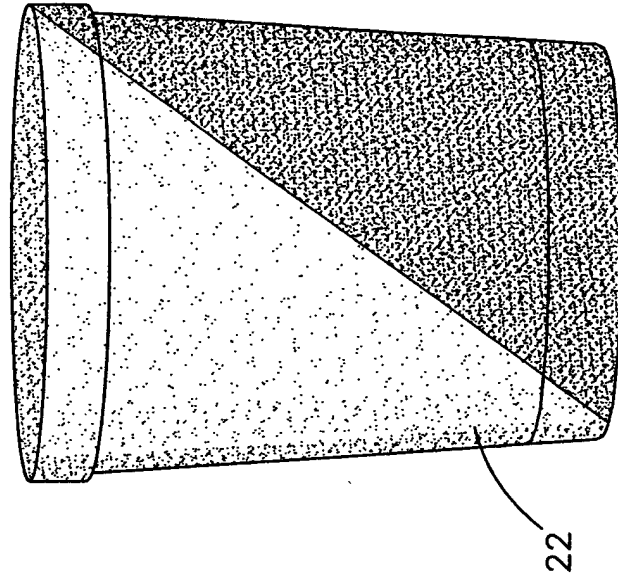


FIG. 3A

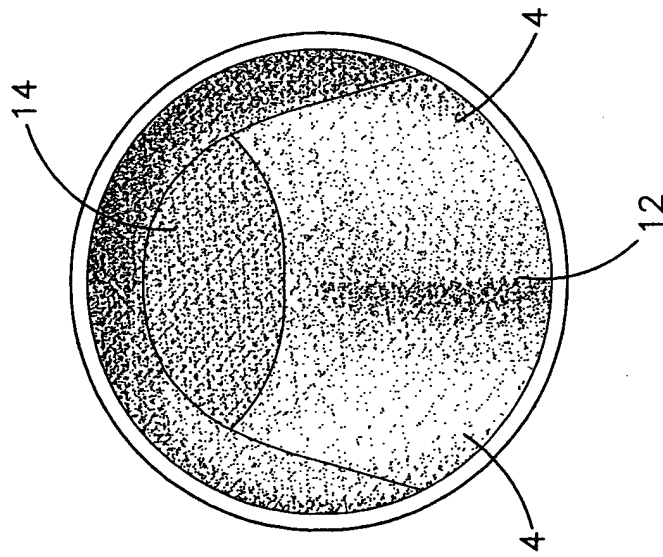


FIG. 3B

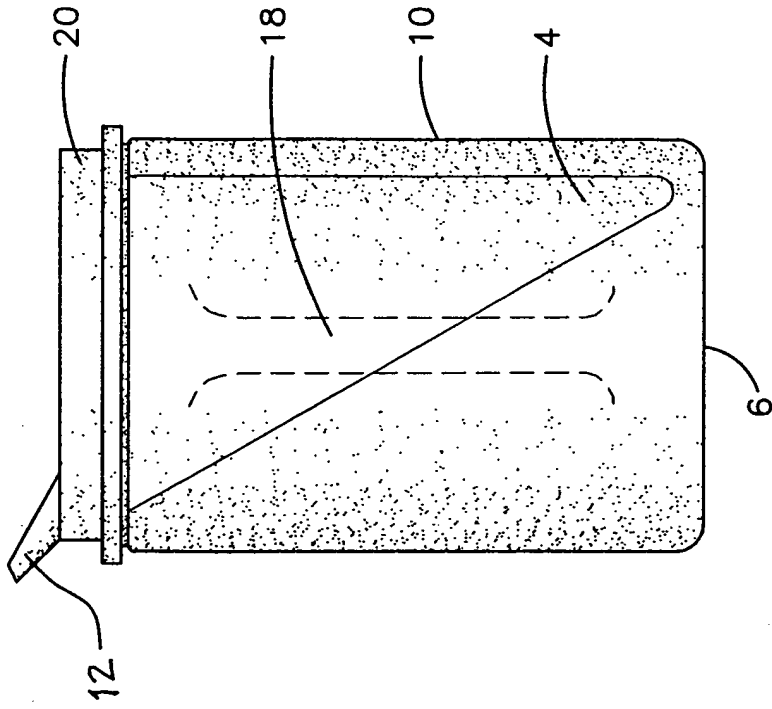


FIG. 4A

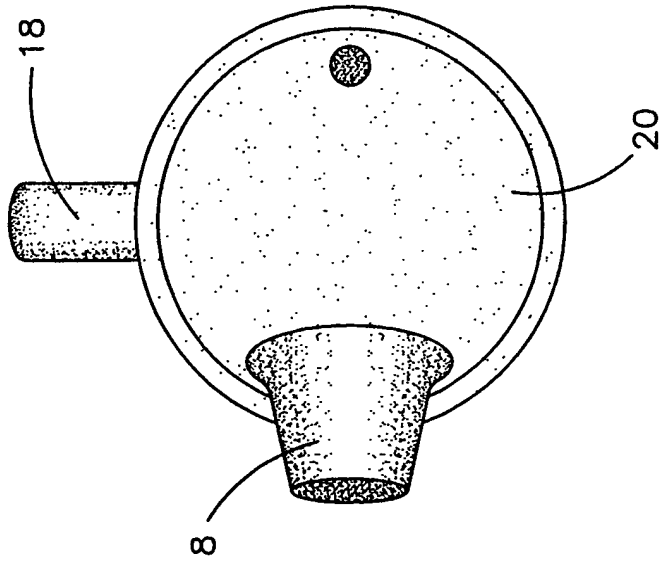


FIG. 4B

TOP VIEW

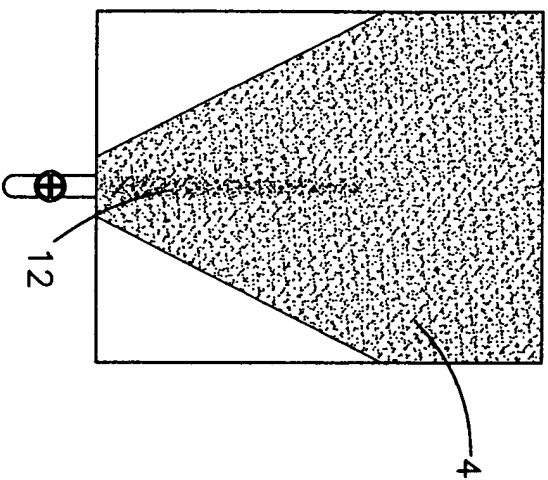


FIG. 6

SIDE VIEW

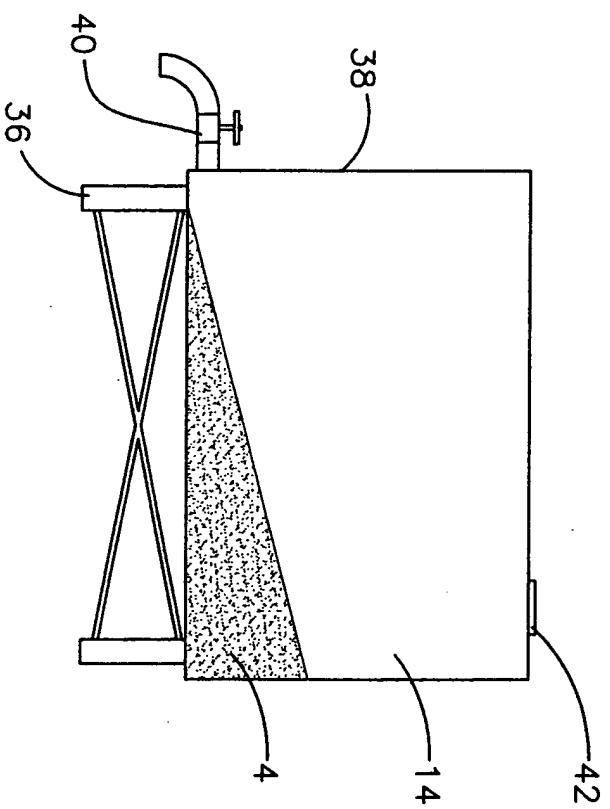


FIG. 5

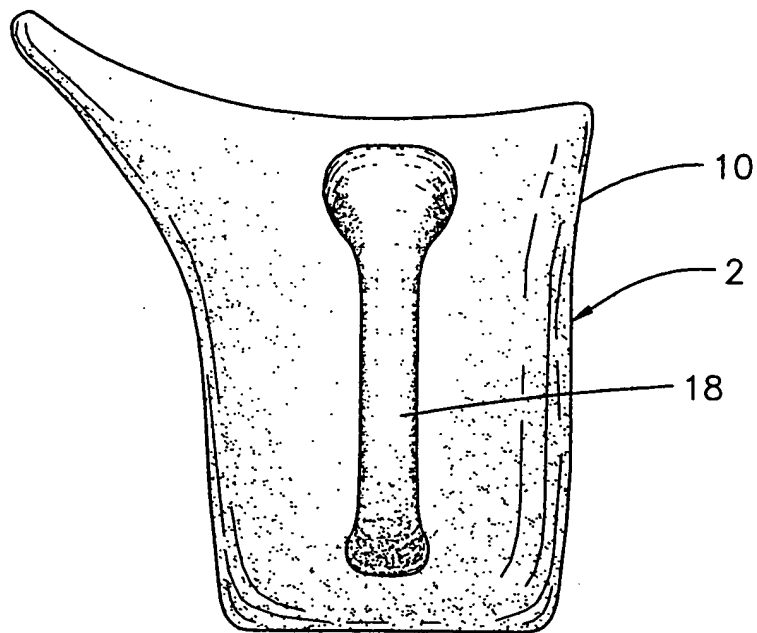


FIG. 1B

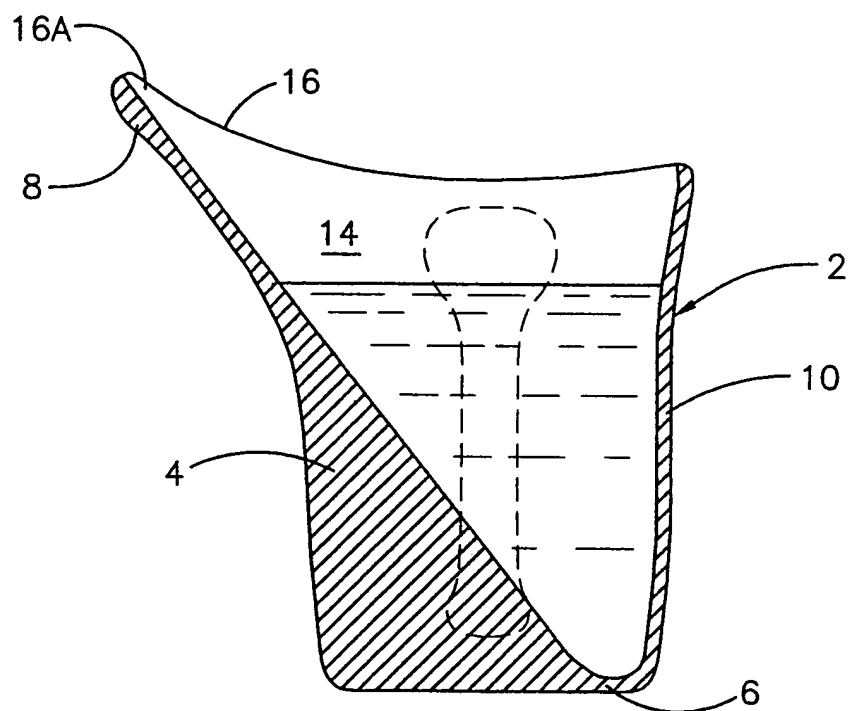


FIG. 1A

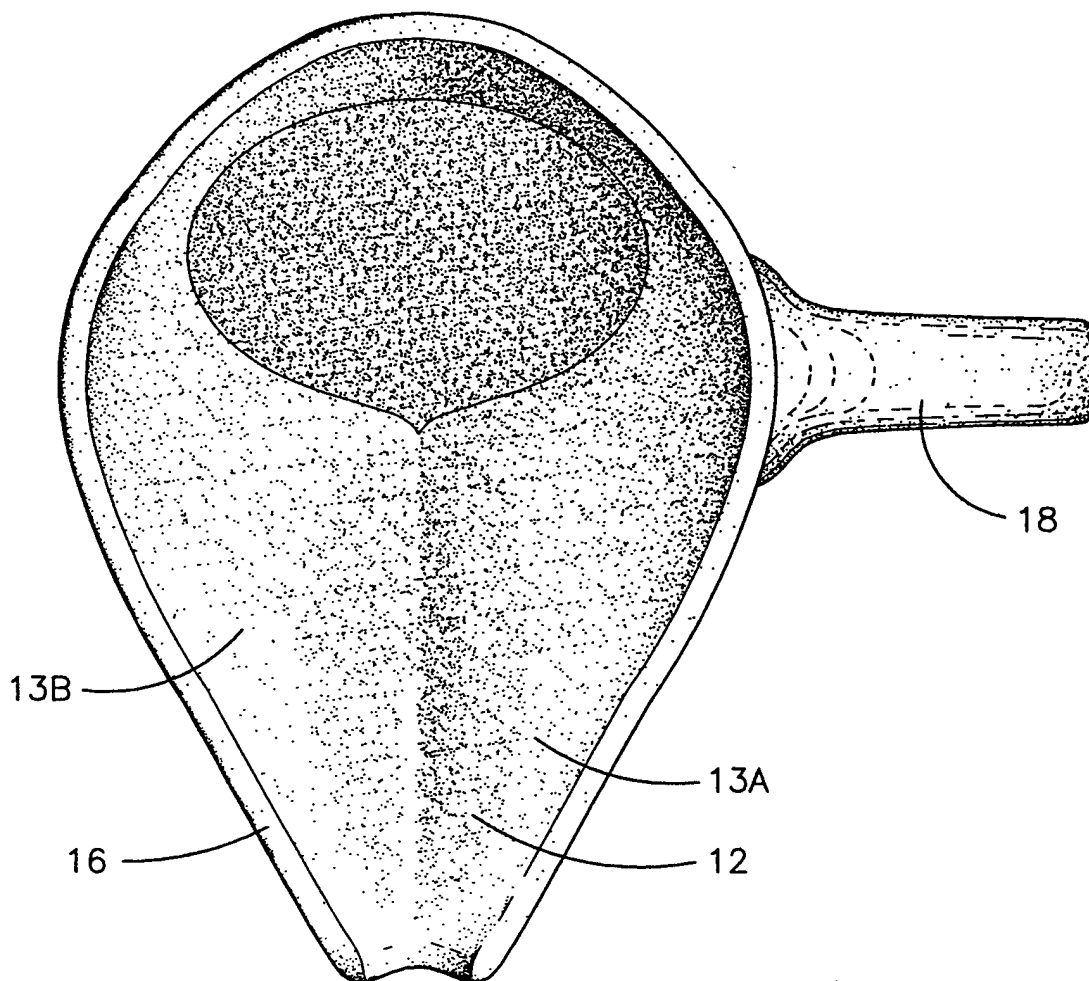


FIG. 1C

TOP VIEW

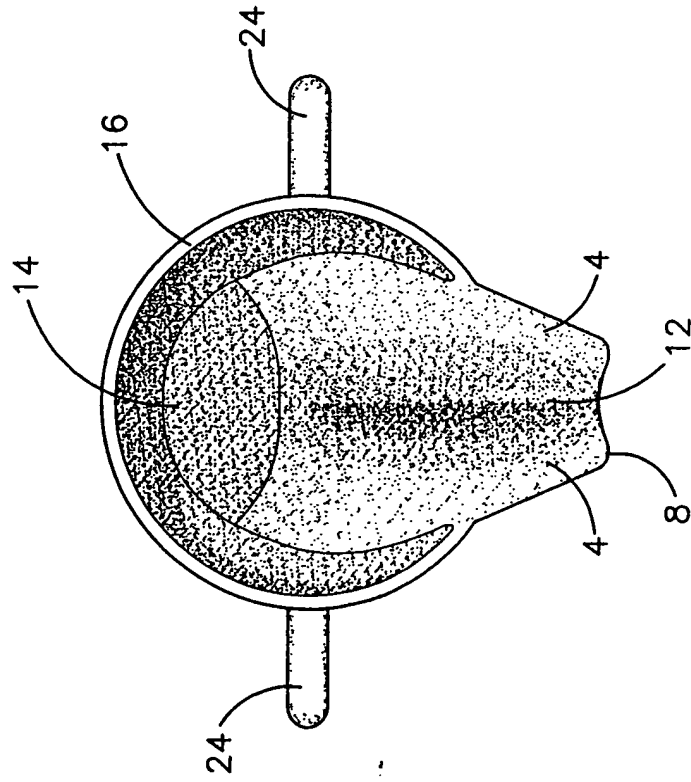


FIG. 2B

SIDE VIEW

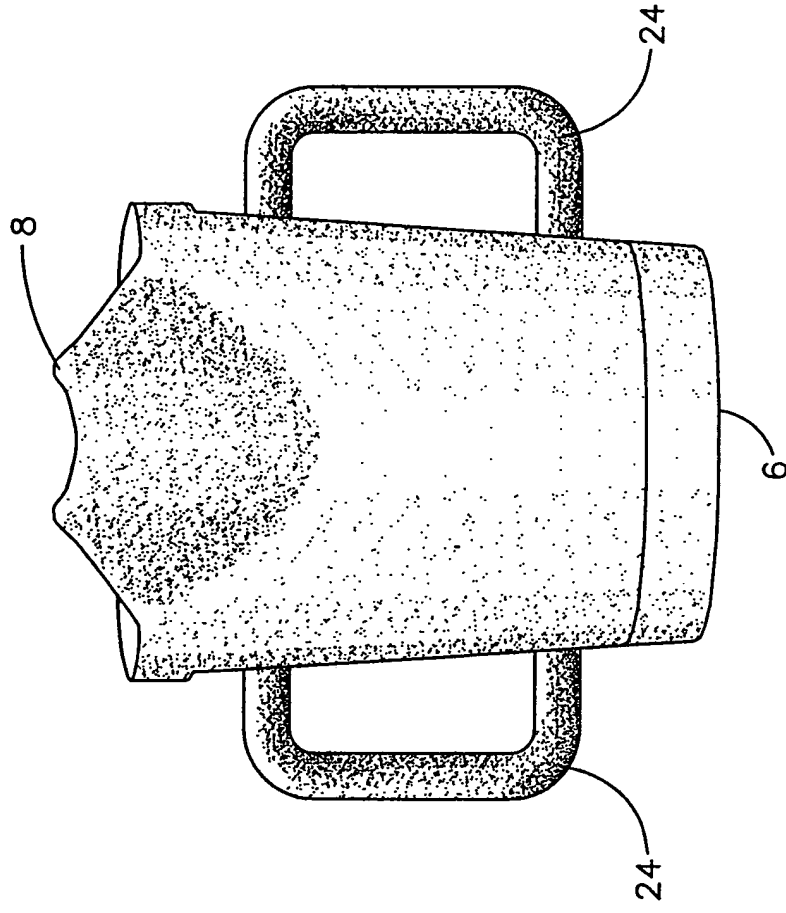


FIG. 2A

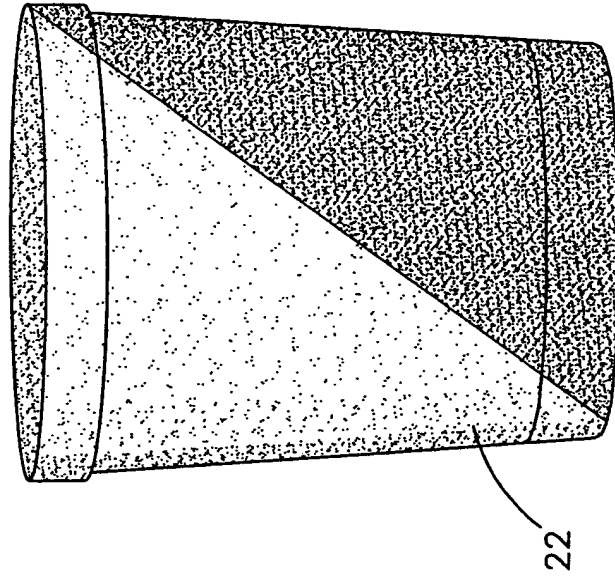


FIG. 3A

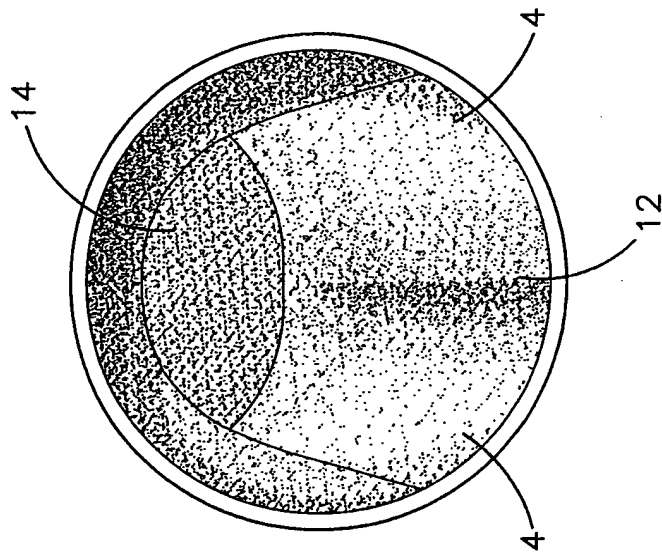


FIG. 3B

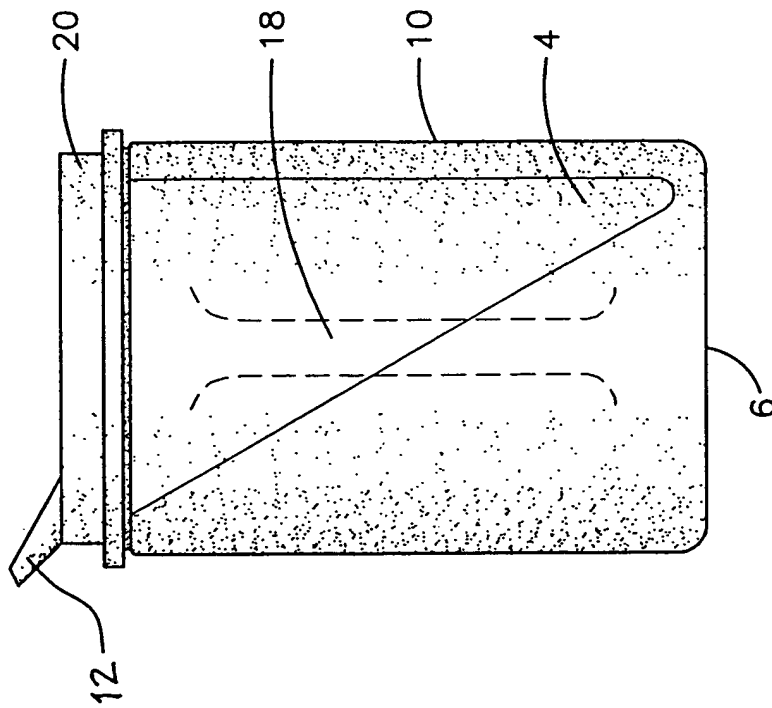


FIG. 4A

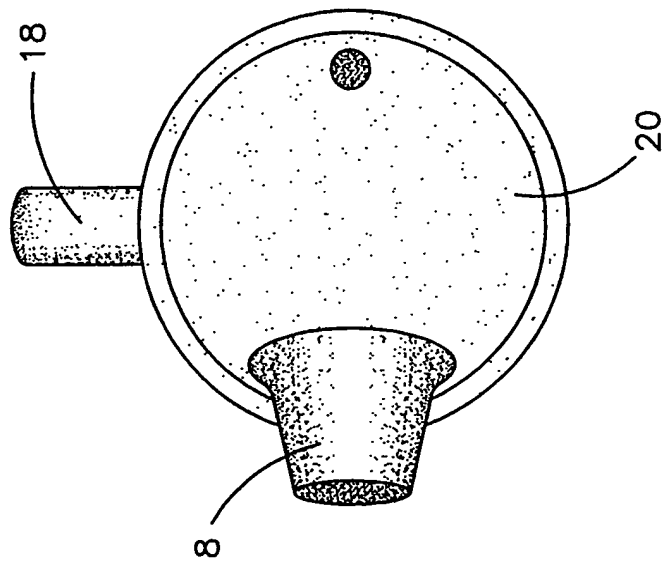


FIG. 4B

TOP VIEW

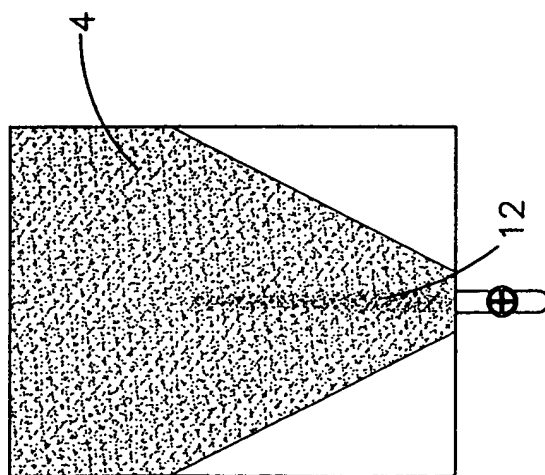


FIG. 6

SIDE VIEW

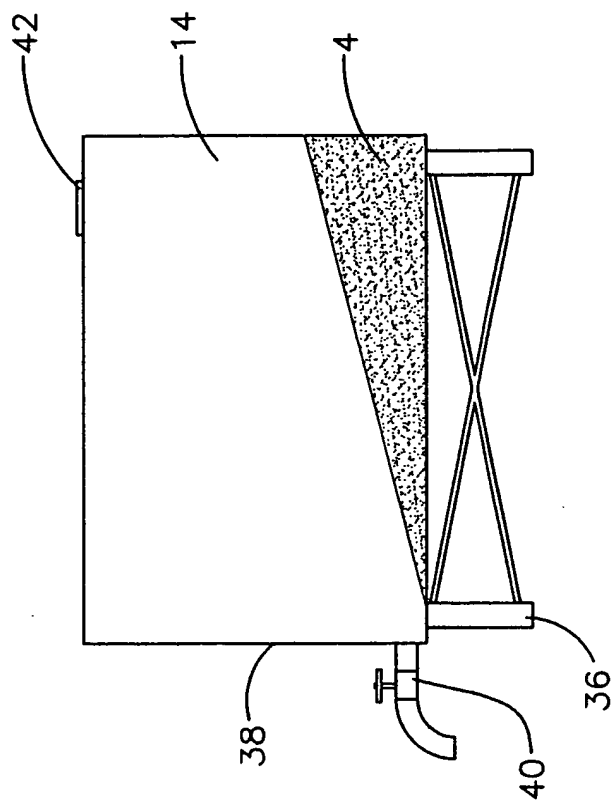


FIG. 5